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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,354	03/01/2004	Rainer Kropke	104035.274384	2393

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,354

Applicant(s)

KROPKE ET AL.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/1/04, 7/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-22 are pending in this application filed 3/1/04, which is a continuation of PCT application filed 8/28/02, which claims priority to German application filed 9/1/01.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Cowan et al. (US 2,594,294).

Cowan et al. teach using iminodisuccinic acid as a stabilizer for glyceride oils of animal or vegetable origin in cosmetic or pharmaceutical compositions. See col. 1, lines 15-37; col. 2, lines 4-12. The iminodisuccinic acid is used in an amount of from 0.005 to

Art Unit: 1616

0.1% by weight. See col. 2, lines 17-20. With respect to Claim 6, patentable weight is not given to the packaging of the composition since the recitation of packaging does not further limit the claimed method. Alternatively, Claim 6 is rejected under 35 U.S.C. 103(a) below. Further, with respect to Claims 7-9, the recitation of specific type of products is not given patentable weight because the body of the claim does not recite any additional ingredients or method steps. The Applicant is invited to recite essential ingredients that make the composition of claim 1 a skin care product, a face care product or a sunscreen product.

Thus, Cowan et al. teach each and every limitation of Claims 1, 2, 4-11, 13 and 14.

4. Claims 10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt (US 6,495,718).

Schmidt exemplifies a cosmetic composition containing 0.1% of iminodisuccinate sodium salt. See col. 5, lines 54-67; col. 6, lines 19-40.

Thus, Schmidt teaches each and every limitation of Claims 10 and 12-14.

5. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Fernandez-Kleinlein et al. (WO 02/19981), supplied by the Applicant.

Fernandez-Kleinlein et al. teach cosmetic and pharmaceutical compositions containing 0.1-95% of a chelating agent such as iminodisuccinate (acid or salt). See Abstract; p. 5, lines 23-25; p. 6, lines 24-32; p. 7, lines 1-10; p. 10, lines 10-15. Fernandez-Kleinlein et al. exemplify compositions containing 3.19%, 3.57%, 5%, 6%,

Art Unit: 1616

7% and 13% of iminodisuccinate. See Examples. The compositions of Fernandez-Kleinlein et al. are applied to the skin for the treatment of various skin conditions such as eczema, irritation and skin dryness. See p. 16, lines 13-20. With respect to Claim 1, the recitation "increasing at least one of the color-stability and the light-stability of a cosmetic or dermatological formulation" is inherent in the reference because the reference teaches the claimed method step, i.e. "adding iminodisuccinic acid or a salt thereof to the cosmetic or dermatological formulation in an amount sufficient to increase at least one of the color-stability and the light-stability of a cosmetic or dermatological formulation."

Thus, Fernandez-Kleinlein et al. teach each and every limitation of Claims 1-4 and 6-13.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1616

8. Claims 6, 15, 16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan et al. (US 2,594,294) in view of either Dallal et al. (US 5,059,414) or Koike et al. (US 6,461,623).

Cowan et al. applied as above. While teaching cosmetic use of iminodicussinic acid, the reference does not explicitly teach the claimed product comprising a transparent or translucent packaging. However, transparent or translucent packaging is known and widely used in the art of cosmetic products for either aesthetic or practical purpose, or both. Thus, Dallal et al. teach packaging multi-phase cosmetic products in transparent container for the desired visual effect. See col. 8, lines 54-56. Koike et al. teach using transparent containers for ascertaining as completely dispersed state of the cosmetic composition. See col. 6, lines 5-10. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Cowan et al. such that to package them in transparent containers. One having ordinary skill in the art would have been motivated to do this to obtain the aesthetic appeal of the product and/or to ensure the homogeneity of the composition before applying it to the skin/hair as suggested by either Dallal et al. or Koike et al.

9. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan et al. (US 2,594,294) in view of Groth et al. (US 6,107,518). Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowan et al. (US 2,594,294) in view of either Dallal et al. (US 5,059,414) or Koike et al. (US 6,461,623) and further in view of Groth et al. (US 6,107,518).

Cowan et al. or Cowan et al. in view of either Dallal et al. or Koike et al. applied as above. While teaching iminodisuccinic acid, the Cowan et al. reference does not explicitly teach iminodisuccinic sodium salt. However, Groth et al. teach using iminodisuccinic alkali metal salts for the same purpose as iminodisuccinic acid, i.e. as complexing agents in the field of cleaning compositions, pharmaceuticals and cosmetics. See col. 1, lines 5-12, 31-35. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Cowan et al. such that to use iminodisuccinic sodium salt instead of iminodisuccinic acid. One having ordinary skill in the art would have a reasonable expectation of obtaining the same complexing effect as set forth in the Cowan et al. reference because these compounds are used interchangeably for the same art-recognized purpose as suggested by Groth et al. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Alternatively, nothing unobvious is seen in substituting the known acid for its salt, as taught by Groth et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results.

10. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Kleinlein et al. (WO 02/19981).

Fernandez-Kleinlein et al. applied as above. The reference does not explicitly teach the claimed concentration range of 0.1-0.5%. However, it exemplifies the composition containing 3.19%, 3.57%, 5%, 6%, 7% and 13% of iminodisuccinate, and broadly teaches the concentration of chelating agent ranging from 0.1 to 95%, preferably 0.2-90%, more preferably 0.4-85%. See p. 10, lines 10-15. Therefore, the determination of optimal or workable concentration of iminodisuccinate chelating agent within the reference's broad range by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired moisturizing properties of the composition.

11. Claims 6 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Kleinlein et al. (WO 02/19981) in view of either Dallal et al. (US 5,059,414) or Koike et al. (US 6,461,623).

Fernandez-Kleinlein et al. applied as above. The reference does not explicitly teach the claimed transparent or translucent packaging. However, transparent or translucent packaging is known and widely used in the art of cosmetic products for either aesthetic or practical purpose, or both. Thus, Dallal et al. teach packaging multi-phase cosmetic products in transparent container for the desired visual effect. See col. 8, lines 54-56. Koike et al. teach using transparent containers for ascertaining as completely dispersed state of the cosmetic composition. See col. 6, lines 5-10. Therefore, it would have been obvious to one having ordinary skill in the art at the time

Art Unit: 1616

the invention was made to modify the compositions of Fernandez-Kleinlein et al. such that to package them in transparent containers. One having ordinary skill in the art would have been motivated to do this to obtain the aesthetic appeal of the product and/or to ensure the homogeneity of the composition before applying it to the skin/hair as suggested by either Dallal et al. or Koike et al.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 93/23515 A1.

13. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.


The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

Art Unit: 1616

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3/17/05


MICHAEL HARTLEY
PRIMARY EXAMINER